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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,719	12/03/2003	Keith A. Thuerk	BOC9-2003-0077 (448)	6364
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AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188				
EXAMINER				
FRITZ, BRADFORD F				
ART UNIT		PAPER NUMBER		
2141				
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09/18/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/726,719

**Applicant(s)**

THUERK, KEITH A.

**Examiner**

BRADFORD F. FRITZ

**Art Unit**

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 8, 10-15, 18, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 10-15, 18, 20, and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see filed 06/04/2008, with respect to the rejection(s) of claim(s) 1-5, 8, 10-15, 18, and 20-25 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Wick (6,691,162), Quillen (7,266,776) et al., and Ogle et al. (6,430,604).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 8, 10-14, 18, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable by Wick (6,691,162) in view of Quillen (7,266,776), hereinafter referred to as Quillen.

4. Regarding claims 1, 11, and 21, Wick disclosed displaying a user selectable list of subscribers of an instant messaging service; selecting a subscriber in an inactive state from the list (column 5, lines 6-55 and Fig. 5), designating at least one action associated with the [subscriber], the at least one designated action to be automatically

performed with respect to each subscriber in the group in response to a state change (column 5, lines 6-55 and Fig. 5 and 4); automatically detecting a state change of at least one of said subscribers in said group (column 5, lines 6-55 and Fig. 5).

However, Wick does not explicitly teach selecting a group of subscribers within a list, designating at least one action with the group, the at least one designated action to be automatically performed with respect to each subscriber in the group in response to a state change, automatically executing said designated action associated with said group for said at least one subscriber responsive to said detecting step. Quillen teaches selecting a group of subscribers within a list (column 10, lines 35-40 and column 12, lines 36-50), designating at least one action with the group (column 10, lines 35-40 and column 12, lines 36-50), the at least one designated action to be automatically performed with respect to each subscriber in the group in response to a state change (column 10, lines 35-40 and column 12, lines 36-50), automatically executing said designated action associated with said group for said at least one subscriber responsive to said detecting step (column 10, lines 35-40 and column 12, lines 36-50). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Quillen in the system of Wick because both are from the same field of endeavor and in order to "facilitate communications between computer users across a network" (*see title*).

5. Regarding claims 2 and 12, Wick disclosed wherein said action is an instant messaging initiation action that initiates an instant messaging session between said client and said at least one subscriber (column 5, lines 6-55 and Fig. 5).

6. Regarding claims 3 and 13, Wick disclosed wherein said action includes at least one action selected from the group consisting of a notification action (column 5, lines 6-55 and Fig. 5), a prompting action (column 5, lines 6-55 and Fig. 5), and a message conveyance action (column 5, lines 6-55 and Fig. 5).
7. Regarding claims 4 and 14, Wick disclosed wherein said selecting, said designating, said associating, said detecting, and said executing steps are performed by said instant messaging client (column 5, lines 6-55 and Fig. 5).
8. Regarding claims 8 and 18, Wick disclosed wherein said state change is a change from an inactive state to an active state (column 5, lines 6-55 and Fig. 5).
9. Regarding claims 10 and 20, Wick disclosed presenting within a graphical user interface a list of said subscribers (column 5, lines 6-55 and Fig. 5), and within said graphical user interface (Fig. 4-5), visually distinguishing said at least one subscriber from other subscribers in said list (column 5, lines 6-55 and Fig. 5).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wick in view of Quillen, further in view of Ogle et al. (6,430,604), hereinafter referred to as Ogle.

12. Regarding claims 5 and 15, Wick disclosed the invention as described above. However, Wick does not explicitly teach wherein said instant messaging client includes a Lotus Sametime (TM) type client. Ogle teaches wherein said instant messaging client includes a Lotus Sametime (TM) type client (column 1, 20-33). It would have been obvious to one of ordinary skill in the art at the time of invention to include the Lotus Sametime IM client in the system of Wick because both Wick and Ogle are from the same field of endeavor of instant messaging and in order to use Wick's "pounce" with another IM client.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

**a. Robinson et al. (6,760,580) teaches organizing subgroups within a buddy list and setting a audiovisual alert for members of a subgroup to go off when those members return online from an inactive state.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRADFORD F. FRITZ whose telephone number is (571)272-3860. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew Caldwell/  
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Examiner, Art Unit 2141